

PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number Q67321	
Mail Stop AF Commissioner for Patents P.O. Box 1450 Alexandria, VA 22313-1450	Application Number 09/987,667		Filed November 15, 2001
	First Named Inventor Naruto ENTANI		
	Art Unit 3693	Examiner Chandler, Sara M.	
<p style="text-align: center;">WASHINGTON OFFICE 23373 CUSTOMER NUMBER</p>			
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal</p> <p>The review is requested for the reasons(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p><input checked="" type="checkbox"/> I am an attorney or agent of record.</p> <p>Registration number <u>59,561</u> <u>/Dion R. Ferguson/</u> Signature</p> <p style="text-align: right;"><u>Dion R. Ferguson</u> Typed or printed name</p> <p style="text-align: right;"><u>(202) 293-7060</u> Telephone number</p> <p style="text-align: right;"><u>May 12, 2008</u> Date</p>			

PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of

Docket No: Q67321

Naruto ENTANI

Appln. No.: 09/987,667

Group Art Unit: 3693

Confirmation No.: 7510

Examiner: Chandler, Sara M.

Filed: November 15, 2001

For: MEDIATION SERVICE METHOD FOR COLLECTING AND SELLING PIECES OF
SELLING PRICE INFORMATION THAT MATCHES A REQUEST

PRE-APPEAL BRIEF REQUEST FOR REVIEW

MAIL STOP AF - PATENTS

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Sir:

Pursuant to the Pre-Appeal Brief Conference Pilot Program, and further to the
Examiner's Final Office Action dated February 11, 2008, Applicant files this Pre-Appeal Brief
Request for Review. This Request is also accompanied by the filing of a Notice of Appeal.

Applicant turns now to the rejections at issue. Claims 1, 5-8 and 12-15 stand rejected
under 35 U.S.C. § 103(a) as being unpatentable over Grdina, U.S. Patent 6,965,872 in view of
Aarnio, U.S. Publication 2004/0078274. Claims 2, 3, 9, 10, 16 and 17 stand rejected under 35
U.S.C. § 103(a) as being unpatentable over Grdina and Aarnio as applied to claims 1 and 8
above, and further in view of Mandler, U.S. Patent 6,785,661. Claims 4 and 11 stand rejected
under 35 U.S.C. § 103(a) as being unpatentable over Grdina and Aarnio as applied to claims 1
and 8 above, and further in view of Luke, U.S. Patent 6,131,087.

As a preliminary matter, Applicants' submit that the Examiner's belief that the word "directly" conflicts with a network environment is misplaced.¹ Applicant submits that a *received* information request is directly communicated to the plurality of information provider terminals.² The Examiner seems to be interpreting the "directly" to mean that the information requester terminal directly communicates with the plurality of information provider terminals. However, this interpretation is not supported by the claim language. Rather, as noted in claim 15, the server directly communicates the previously received information request to the plurality of information provider terminals. Thus, Applicant submits that claim 1, and analogously claim 15, are written correctly.

Further, the Examiner continues to allege that a proposed combination of Grdina and Aarnio discloses all of the elements of claim 1. Specifically, the Examiner argues that "[i]n Grdina, the communication devices (e.g., telephone, computer, vehicle, pda, etc.) are akin to the terminals of the claimed invention. In Grdina, the consumers/customers are akin to the information requesters. In Grdina, the retailers/business owners are akin to the information providers. In Grdina, in addition to the system receiving information requests from the consumers/customers, the system also communicates information requests directly to the retailers/business owners."³ The Examiner then concludes that claims 1-17 would have been

¹ See Final Office Action dated February 11, 2008, pages 19-21.

² Applicant would further direct the Examiner to Applicant's comments regarding this issue on pages 11 and 12 of the Amendment filed December 5, 2007.

³ See Final Office Action, dated February 11, 2008, page 21.

obvious because “claims 1-17 are merely using a known technique to improve a similar device in the same way,” citing KSR.⁴ Applicants respectfully disagree.

Claim 1 requires that the information request *received from* the information requester terminal is *communicated directly to* a plurality of information provider terminals. As noted on page 12 of the Amendment filed December 5, 2007, and further emphasized herein, Grdina, on the other hand, indicates that retailers may upload prices for goods/services to a database and further allows a retailer to collect and sort data regarding competitors. However, any information request submitted by a consumer merely searches the database and returns results. The actual received information request is not forwarded to retailers by the database. Therefore, Grdina cannot disclose “communicating the information request directly to a plurality of information provider terminals” as recited in claim 1, and as alleged by the Examiner.

Aarnio fails to cure the deficient disclosure of Grdina as the server disclosed in Aarnio fails to send an information request from a customer to the actual information provider terminals.

With regard to the Examiner’s reliance on KSR, as noted above, claim 1, and analogously claims 8 and 15, do not perform a known technique in a similar way. Rather, claim 1 performs a specific method for performing mediating and supplying of selling price information, where the method is performed differently from the method disclosed in Grdina. Thus, the Examiner’s reliance on KSR is misplaced.

⁴ See Final Office Action dated February 11, 2008, page 22.

In the Advisory Action dated April 28, 2008, the Examiner has not provided any further comments in rebuttal of the arguments submitted in the Amendment dated February 11, 2008.

Conclusion

For the reasons noted above, Applicant submits that claim 1 is patentable over the applied art. Claims 8 and 15 recite limitations similar to claim 1, and are patentable for reasons analogous thereto. Claims 2-7, 9-14, 16 and 17 are patentable at least by virtue of their respective dependencies.

Thus, Applicants respectfully request reconsideration of the Advisory Action and withdrawal of each of the rejections under 35 U.S.C. § 103(a) of claims 1-17.

Respectfully submitted,

/Dion R. Ferguson/

SUGHRUE MION, PLLC
Telephone: (202) 293-7060
Facsimile: (202) 293-7860

WASHINGTON OFFICE

23373

CUSTOMER NUMBER

Dion R. Ferguson
Registration No. 59,561

Date: May 12, 2008